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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,775	03/22/2004	Weston F. Harding	4165-031902	9937

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EXAMINER
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SONNETT, KATHLEEN C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/805,775

Applicant(s)

HARDING ET AL.

Examiner

Kathleen Sonnett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-16, 21, and 24 is/are allowed.
- 6) ☒ Claim(s) 17, 22, 23, 26 and 32 is/are rejected.
- 7) ☐ Claim(s) 18-20, 25 and 27-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/28/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. **Claim 25** is objected to because of the following informalities: wording. Claim 25 recites the limitation that the guard has a pair of engagement elements that bias the arms of the blade outwardly. However, the arms of the blade appear to be biased inwardly and the engagement elements of the guard are holding them outwardly. Rewording is suggested such as changing the phrase "to bias the arms outwardly" to the phrase "to hold the arms in an outward configuration [or position]". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. **Claim 26** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 26 recites the limitation "the handle" in lines 6 and 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 22 and 32** are rejected under 35 U.S.C. 102(b) as being anticipated by Herbert et al. (U.S. 5,868,771). Herbert et al. discloses a surgical scalpel assembly comprising a handle (100) comprising a blade attachment element (103), a blade (300) comprising an attachment member (301) configured to engage the attachment element of the handle and a guard (200) configured to engage the handle, the guard comprising a blade deflection device (218) that holds the rear portion of the blade in a deflected position in the guard (see Fig. 6 and col. 7 lines 13-20).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Frassetti (U.S. 5,116,351) in view of Overholt (U.S. 6,574,868). Frassetti discloses the invention substantially as comprising a handle having a blade carrier with a blade attachment element (22), a guard with a retaining arm (18) having a boss (32), and a blade with a slot (hole in 24 seen in Fig. 6) configured to engage the attachment element of the blade carrier and a retaining hole (30) configured to engage the retaining boss of the guard. Frassetti fails to disclose a retaining boss that is non-arcuate or a retaining hole that is non-arcuate.

9. However, Overholt discloses that it is old and well known in the art of cutting devices to have a non-arcuate element, which slides in a non-arcuate hole or slot. Overholt discloses a slide lock (66), which is being considered the retaining arm and is similar to the retaining arm and boss configuration of Frassetti. The retaining arm (66) has non-arcuate boss (64) that fits into the non-arcuate channel (62). The retaining arm and non-arcuate boss slide along the non-arcuate channel between two positions as seen in Fig. 7 and 8. Changing the retaining boss (32) of the guard and the retaining hole (30) of the blade to a non-arcuate shape would not effect the performance of the device disclosed by Frassetti as the retaining boss (32) must only be able to fit into the channel (34) and the retaining hole (30), and slide along the channel. No pivoting is required around this point and therefore, a non-arcuate shape would work equally as well. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute a non-arcuate shaped boss and non-arcuate shaped retaining hole to engage the boss as made obvious by Overholt for the arcuate boss

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and hole disclosed by Frassetto since Overholt teaches that a non-arcuate slide lock configuration performs equally as well as an arcuate slide lock configuration.

10. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson (U.S. 2,280,463) in view of Christy (2,074,640). Williamson discloses a scalpel assembly comprising a handle (2) with a locking device (16), a blade (3) with a locking element (15), and a guard (4). The guard comprises a locking arm (14) configured to engage the locking element of the blade when the guard is in a first position and configured to engage the locking device of the handle when the guard is in a second position. In the invention disclosed by Williamson, the handle (2) and blade (3) are one piece and therefore, Williamson fails to disclose the attachment member on the blade configured to engage the handle and the blade attachment element on the handle configured to engage the blade.

11. However, Christy discloses that it is old and well known in the art to use blades that are not integrally formed with the handle, but instead are separate elements that are detachably joined. Christy discloses that a detachable blade allows for the replacement of the blade should it become dull, broken, or worn (col. 2 lines 8-14). Making the handle and blade of the invention disclosed by Williamson separate elements would allow the blade to be replaced once it becomes dull. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device disclosed by Williamson to include an attachment member on the blade configured to engage the handle and a blade attachment element on the handle configured to engage the blade

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as made obvious by Christy in order to gain the advantage of having a new, sharp blade without having to replace the entire device.

***Allowable Subject Matter***

12. Claims 1-16, 21, and 24 are allowed.
13. Claim 26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
14. Claims 18-20 and 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,629,985 discloses a guard with an arm that engages an aperture in the blade when the guard and blade assembly are detached from the handle. The engagement member of the handle pushes the arm of the guard out of the aperture of the blade when the guard and blade assembly are attached to the handle. U.S. Patent 5,676,677 shows a guard and blade assembly wherein the blade has multiple apertures besides the handle attachment slot and the guard engages with multiple pins and the multiple apertures on the blade.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCS  
5/9/2006

  
GLENN K. DAWSON  
PRIMARY EXAMINER